



PATENT  
Customer No. 22,852  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Gilles RUBINSTENN et al.	)	Group Art Unit: 3639
	)	
Application No.: 10/024,496	)	Examiner: Igor N. BORISSOV
	)	
Filed: December 21, 2001	)	
	)	
For: BEAUTY ADVISORY SYSTEM	)	Confirmation No.: 4463
AND METHOD	)	

**Attention: Mail Stop Appeal Brief-Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Pursuant to 37 C.F.R. § 41.41, Appellants submit this Reply Brief in response to the Examiner's Answer dated April 20, 2006.

If any additional fees are required in connection with the filing of this Reply Brief, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

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**I. STATUS OF CLAIMS**

Claims 1-50 have been finally rejected and are subject to this appeal.

## II. GROUNDS OF REJECTION

In the Examiner's Answer mailed April 20, 2006, the Examiner **withdrew** the rejection of claims 27-30, 40, 42, and 45 under 35 U.S.C. § 112, ¶ 2 and **withdrew** the rejection of claims 1-26 and 32-50 under 35 U.S.C. § 101. The remaining grounds of rejection are listed below:

A. Claims 25 and 26 stand rejected under 35 U.S.C. § 102(a) based on WO 01/18674 ("*Maloney*"). *Id.* at 7, 8; Interview Summary of Oct. 25, 2005 ("*Interview Summary*").

B. Claims 1-9, 11-13, 17, 18, 20-24, 27, 30-32, and 34-50 stand rejected under 35 U.S.C. § 103(a) based on *Maloney* and U.S. Patent No. 5,796,932 ("*Fox*"). *Final Office Action* at 8-17; *Interview Summary*.

C. Claim 10 stands rejected under 35 U.S.C. § 103(a) based on *Maloney*, *Fox*, and U.S. Patent Application Publication No. 2002/0082869 ("*Anderson*"). *Final Office Action* at 17, 18.

D. Claim 19 stands rejected under 35 U.S.C. § 103(a) based on *Maloney*, *Fox* and Official Notice. *Id.* at 19.

E. Claims 14-16, 28, 29, and 33 stand rejected under 35 U.S.C. § 103(a) based on *Maloney*, *Fox*, and U.S. Patent Application Publication No. 2002/0059248 ("*Farchione*"). *Id.* at 18, 19.

### III. ARGUMENT IN REPLY

#### A. Rejection Under 35 U.S.C. § 102(a) Over *Maloney*

##### 1. Claims 25 and 26

a. The rejection of claims 25 and 26 under 35 U.S.C. § 102(a) is improper because *Maloney* does not disclose the elements being arranged as required by the claim.

On page 21 of the Examiner's Answer, the Examiner attempts to equate providing a test kit to a consumer to test for environmental information in *Maloney* with "accessing local information for the geographic area," as recited in claim 25. This is improper. In order to anticipate a claimed invention under 35 U.S.C. § 102(a), the elements in a prior art reference must be arranged exactly as required by the claim. See M.P.E.P. § 2131. In this instance, the teachings of *Maloney* are not arranged as required by claim 25. Specifically, providing a test kit to a consumer to test for environmental information in *Maloney* is not the same as and does not constitute "accessing local information for the geographic area."

By way of illustration, in one embodiment of the claimed invention, temperature information is accessed and provided to a user. See Fig. 1 of Application Drawings (local information of Springfield, VA is accessed to display a temperature of 40° F to 60° F). In contrast, *Maloney* discloses "the collection of profiling data about a consumer comprises providing the consumer a test kit. . . . Preferably, such a test kit would also comprise additional environmental tests (such as water hardness, water pH, etc.) which effect [sic] the performance of beauty care products." See *Maloney*, at 11, lines 6-12 (underline added by Examiner). Hence, *Maloney* does not teach "accessing local information for the geographic area," but merely discloses providing a test kit to a

consumer to test for environmental information. Accordingly, the rejection of claims 25 and 26 under 35 U.S.C. § 102(a) should be reversed at least because the teachings of *Maloney* are not arranged as required by claim 25 and its dependent claim 26.

**b. Even if one assumes customizing a product includes an implicit attempt to sell the customized product, customizing and attempting to sell the product is not the same as and does not constitute “generating a recommendation for use” of the product.**

On page 21 of the Examiner’s Answer, the Examiner alleges providing customized shampoo or lotion in *Maloney* constitutes “generating a recommendation for use of a product on the list,” as recited in claim 25. Appellants note that this allegation completely misses one feature of claim 25. That is, the invention of claim 25 is not directed to customization of a product selected from a list. The invention of claim 25 is instead, directed to generating a recommendation on use of a product. This is separate from and unrelated to *Maloney*’s product customization. For instance, in the invention of claim 25, the recommendation for use of the product is generated regardless of whether the product is customized.

Further, the claim expressly recites generating a recommendation. Hence, a recommendation is something that is actually generated and may, for example, be presented as words on a website, stating “Here is what we recommend for you today based on the local information . . . ,” as shown in Fig. 1, in one embodiment of the invention. *Maloney* fails to teach or suggest this. *Maloney* merely discloses customizing a product. Even if one assumes customizing a product includes an implicit attempt to sell the customized product, customizing and attempting to sell the product are not the same as and do not constitute “generating a recommendation for use” of the

product. Accordingly, *Maloney* does not teach “generating a recommendation for use.” It merely teaches customizing the product. The rejection of claims 25 and 26 under 35 U.S.C. § 102(a) should be reversed for at least these reasons.

**B. Rejection Under 35 U.S.C. § 103(a) Based On *Maloney* and *Fox***

**1. Claims 1-9, 11-13, 17, 18, 20-24, 30, 31, and 48**

**Rather than being directed to providing shampoo or lotion as alleged by the Examiner, claim 1 is directed to generating and presenting at least one recommendation for use of a cosmetic product.**

On page 22 of the Examiner’s Answer, the Examiner alleges providing shampoo or lotion constitutes generating and presenting at least one recommendation for use of a cosmetic product. However, the invention in claim 1 is not directed to providing shampoo or lotion. It is instead, directed to generating and presenting at least one recommendation for use of a cosmetic product. This is separate from and unrelated to providing shampoo or lotion.

For instance, claim 1 expressly recites generating and presenting a recommendation. Hence, a recommendation is something that is expressly generated and presented, for example, as words on a website, stating “Here is what we recommend for you today based on the local information . . . ,” as shown in Fig. 1, in one embodiment of the invention. *Maloney* fails to teach or suggest such subject matter. *Maloney* merely discloses providing shampoo or lotion. Accordingly, *Maloney* does not teach “generating and presenting at least one recommendation for use of” a cosmetic product “based on at least personal information and local information,” and “presenting the at least one recommendation,” as recited in claim 1.



Further, on page 23 of the Examiner's Answer, the Examiner asserts that the alleged motivation to combine *Maloney* and *Fox* would be to utilize "local actual and forecasted weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits." *Examiner's Answer*, at 23. However, even if such a motivation hypothetically existed (which it does not), this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions as disclosed in *Maloney*, and using local weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits as allegedly disclosed in *Fox*. This combination is not the same as and does not suggest generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information, which is determined based on demographic information, and presenting the at least one recommendation, as recited in claim 1.

Accordingly, the rejection of claims 1-9, 11-13, 17, 18, 20-24, 30, 31, and 48 under 35 U.S.C. § 103(a) over *Maloney* and *Fox* should be reversed for at least the reasons discussed above.

**2. Claim 27**

***Maloney* merely discloses customizing a product, not generating a recommendation, as recited in claim 27.**

On page 24 of the Examiner's Answer, the Examiner alleges customizing beauty products constitutes "generating a recommendation for use of at least one cosmetic product, where the recommendation is a function of the personal information of the subject and the local information," as recited in claim 27. The Examiner's allegation

completely misses one feature of the invention in claim 27. That is, the claimed invention is not directed to customizing beauty products. The invention of claim 27 is instead, directed to generating a recommendation on use of a cosmetic product. This is separate from and unrelated to *Maloney's* product customization. For instance, in the invention of claim 27, the recommendation for use of the product is generated regardless of whether the product is customized.

Further, the claim expressly recites generating a recommendation. Hence, a recommendation is something that is expressly generated and may, for example, be presented as words on a website, stating "Here is what we recommend for you today based on the local information . . . ," as shown in Fig. 1, in one embodiment of the invention. *Maloney* fails to teach or suggest subject matter. *Maloney* merely discloses customizing a product. Even if one hypothetically assumes customizing a product includes an implicit attempt to sell the customized product (which is not true), customizing and attempting to sell the product are not the same as and do not constitute "generating a recommendation for use" of the product.

Accordingly, *Maloney* does not teach "generating a recommendation for use," as recited in claim 27. It merely teaches customizing the product. Thus, the rejection of claim 27 under 35 U.S.C. § 102(a) should be reversed for at least this reason.

Further, on page 25 of the Examiner's Answer, the Examiner asserts that the alleged motivation to combine *Maloney* and *Fox* would be to utilize "local actual and forecasted weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits." However, even if such a motivation hypothetically existed (which is not true), this motivation would only yield the

combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions (e.g., water hardness, water pH) as disclosed in *Maloney*, and using local weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits as allegedly disclosed in *Fox*. This combination is not the same as and does not suggest "generating a recommendation for use of at least one cosmetic product, where the recommendation is a function of the personal information of the subject and the local information," as recited in claim 27.

Accordingly, the rejection of claim 27 under 35 U.S.C. § 103(a) over *Maloney* and *Fox* should be reversed for at least the reasons discussed above.

### 3. Claims 32-40

**Nothing in *Maloney* or *Fox* teaches or suggests using the local weather information to generate differing cosmetic product usage recommendations as a function of a weather forecast, as recited in claim 32 and required by its dependent claims 33-40.**

On page 25-26 of the Examiner's Answer, the Examiner apparently alleges that *Maloney* and *Fox* disclose "generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information that includes a weather forecast," as recited in claim 32. To the contrary and as discussed above, *Maloney* merely discloses customizing products to meet a consumer's physiological and environmental conditions (e.g., water hardness, water pH). *Fox* merely discloses using local weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products. Nothing in *Maloney* or *Fox* teaches or suggests using the local weather information to generate differing cosmetic

product usage recommendations as a function of a weather forecast, as recited in claim 32 and required by its dependent claims 33-40.

Accordingly, the rejection of claims 32-40 under 35 U.S.C. § 103(a) over *Maloney* and *Fox* should be reversed for at least the reasons discussed above.

**4. Claims 41 and 42**

**Customizing beauty products does not teach or suggest generating a recommendation for use of a cosmetic product, or generating the recommendation based on local information obtained by manipulating received demographic data.**

On page 26 of the Examiner's Answer, the Examiner apparently alleges customizing beauty products in *Maloney* constitutes "generating at least one recommendation for use of at least one cosmetic product based on local information obtained by manipulating received demographic data," as recited in claim 41. As discussed above, customizing beauty products does not teach or suggest generating a recommendation for use of a cosmetic product, much less generating the recommendation based on local information obtained by manipulating received demographic data.

Further, on page 27 of the Examiner's Answer, the Examiner asserts that the alleged motivation to combine *Maloney* and *Fox* would be to utilize "local actual and forecasted weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits." *Examiner's Answer*, at 27. However, even if such a motivation hypothetically existed (which it does not), this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions (e.g., water hardness, water pH) as disclosed in *Maloney*, and using local

weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits as allegedly disclosed in *Fox*. This combination is not the same as and does not suggest “generating at least one recommendation for use of at least one cosmetic product based on local information obtained by manipulating received demographic data,” as recited in claim 41 (emphasis supplied) and required in its dependent claim 42.

Accordingly, the rejection of claims 41 and 42 under 35 U.S.C. § 103(a) over *Maloney* and *Fox* should be reversed for at least the reasons discussed above.

#### 5. Claims 43-47

**Providing a list of consumer services or goods does not constitute generating at least one cosmetic analysis, as recited in claim 43.**

On page 27 of the Examiner's Answer, the Examiner alleges that *Maloney* teaches “generating at least one cosmetic analysis based on at least one of the personal information and the local information,” as recited in the claim 43. However, *Maloney* merely discloses providing a list of products, which may include “consumer services (such as film development)” or “consumer goods (such as beauty care products, clothing, electronics, etc.).” *Maloney*, at 7, lines 14-17. Providing a list of consumer services or goods does not constitute generating at least one cosmetic analysis, as recited in claim 43.

Further, providing a list of consumer services or goods does not constitute presenting the generated cosmetic analysis, as recited in claim 43. The cosmetic analysis is something that is expressly generated and presented. *Maloney* fails to teach or suggest this.

Also, on page 28 of the Examiner's Answer, the Examiner asserts that the motivation to combine *Maloney* and *Fox* would be to utilize "local actual and forecasted weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits." *Examiner's Answer*, at 28. However, even if such a motivation hypothetically existed (which it does not), this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions (e.g., water hardness, water pH) as disclosed in *Maloney*, and using local weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits as allegedly disclosed in *Fox*. This combination is not the same as and does not suggest "generating at least one cosmetic analysis based on at least one of the personal information and the local information," and "presenting the at least one cosmetic analysis," as recited in claim 43 (emphasis supplied) and required in its dependent claims 44-47.

Accordingly, the rejection of claims 43-47 under 35 U.S.C. § 103(a) over *Maloney* and *Fox* should be reversed for at least the reasons discussed above.

**6. Claims 49 and 50**

**Customizing beauty products does not teach or suggest generating a recommendation for use of a cosmetic product, or generating the recommendation based on demographic information and historical information associated with a geographic area.**

On page 29 of the Examiner's Answer, the Examiner alleges customizing beauty products in *Maloney* constitutes generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the

local information, which is based on demographic information and historical information associated with a geographic area, as recited in claim 49. As discussed above, customizing beauty products does not teach or suggest generating a recommendation for use of a cosmetic product, much less generating the recommendation based on demographic information and historical information associated with a geographic area.

Further, on page 30 of the Examiner's Answer, the Examiner again asserts that the alleged motivation to combine *Maloney* and *Fox* would be to utilize "local actual and forecasted weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits." However, even if such a motivation hypothetically existed (which it does not), this alleged motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions (e.g., water hardness, water pH) as disclosed in *Maloney*, and using local weather information (e.g., temperature and humidity) in planning sales and advertising of personal care products to maximize profits as allegedly disclosed in *Fox*. This combination is not the same as and does not suggest "generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information, which is based on demographic information and historical information associated with a geographic area," as recited in claim 49 (emphasis supplied) and required in its dependent claim 50.

Accordingly, the rejection of claims 49 and 50 under 35 U.S.C. § 103(a) over *Maloney* and *Fox* should be reversed for at least the reasons discussed above.

**C. Rejection Under 35 U.S.C. § 103(a) Based On *Maloney*, *Fox*, and *Anderson***

**1. Claim 10**

**Appellants' claims are being used in hindsight to reconstruct the prior art.**

On page 31 of the Examiner's Answer, the Examiner misconstrues Appellants' arguments regarding hindsight. Appellants recognize that a judgment on obviousness requires an analysis to evaluate the understanding of one of ordinary skill in the art at the time of the invention, but in this instance, Appellants can only conclude that the Examiner is using the teachings of Appellants' claims in hindsight to reconstruct the prior art. This is improper. The Examiner may only use the prior art to make a judgment on obviousness.

For example, the Examiner apparently asserts that a skilled artisan would have modified *Maloney* and *Fox* with the disclosure of *Anderson* to yield the invention in claim 10, "because it would advantageously allow [a determination and exclusion of] certain beauty product ingredients which may cause negative health conditions or even diseases to which the consumer may have a predisposition." *Final Office Action* at 18. However, the Examiner pointed to no support in *Maloney*, *Fox*, *Anderson*, or any other sources that teaches excluding beauty product ingredients based on negative health conditions or predispositions. The Examiner also failed to show that the alleged motivation would have been in the knowledge generally available to one skilled in the art. Indeed, the Examiner's Answer does not provide any indication in the prior art to support the alleged motivation to combine *Anderson* with *Maloney* and *Fox* to yield the claimed invention. Hence, Appellants can only conclude that the Examiner is



improperly using the teachings of Appellants' claims in hindsight to reconstruct the prior art.

**D. Rejection Under 35 U.S.C. § 103(a) Based On *Maloney, Fox, and Farchione***

**1. Claims 14-16, 28, 29, and 33**

Appellants submit no additional arguments in reply to this rejection.

**E. Rejection Under 35 U.S.C. § 103(a) Based On *Maloney, Fox, and Official Notice***

**1. Claim 19**

**The allegation that consumers use cosmetic products daily does not support the assertion that it was well known to suggest that the subject maintain a stock of the plurality of cosmetic products, as recited in claim 19.**

On page 34 of the Examiner's Answer, the Examiner alleges that "documentary evidence" supports the Official Notice that it was old and well known for consumers to have a habit of using a cosmetic product every day. However, even if it were allegedly obvious or well known that "a lot of consumers have a habit to use cosmetic product[s] every day," the Examiner failed to establish that claim 19 as a whole, including the "suggesting" feature would have been obvious. Specifically, the allegation that consumers use cosmetic products daily does not support the assertion that it was allegedly well known to suggest that the subject maintain a stock of the plurality of cosmetic products, as recited in claim 19. For at least the foregoing reasons, the Examiner has failed to meet his burden to establish a *prima facie* case of obviousness.

#### IV. CONCLUSION

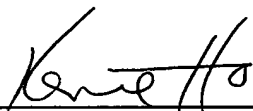
For the above reasons and the reasons stated in Appellant's Appeal Brief of February 3, 2006, all of the claim rejections are erroneous and reversal of the rejections is respectfully requested.

If any additional fees are required in connection with the filing of this Reply Brief, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 12, 2006

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